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EXAMINER

KAPADIA, MILAN S

ART UNIT PAPER NUMBER

3626

DATE MAILED: 04/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/394,341

Applicant(s)

MORAG ET AL.

Examiner

Milan S Kapadia

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 March 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 87-118 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 87-118 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the application filed 13 November 1999. Claims 87-118 are pending.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 87 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(A) Claim 87 recites the limitation "said patient's medical profile " in line 7. There is insufficient antecedent basis for this limitation in the claim. For the purpose of prior art rejection, the examiner assumes "said patient's medical profile" to be "a patient's medical profile."

Claim Rejections - 35 USC § 103

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4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 87, 88, 92, 97-99, and 103-111 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hawkins et al. (6,343,318; as cited in the previous Office Action) in view of Sato et al. (5,911,687; as cited in the previous Office Action) and further in view of Sloane (5,619,991).

(A) As per claim 87, Hawkins teaches a method of messaging upon a network between patients and healthcare providers comprising:

initiating a query message from a patient-operated computer using a first medical messaging wizard (Hawkins; col. 3, lines 35-39; the examiner interprets the "client" as the "patient operated computer");

generating an electronic form for a user to complete by said by said first medical messaging wizard, wherein a form completed by said user comprises a query message (Hawkins; col. 3, lines 53-58 and col. 12, lines 40-67);

sending said query message to a workflow engine at a separate network location from said patient-operated computer (Hawkins; col. 3, lines 39-40; the examiner interprets the "server" as the "workflow engine");

routing said query message with said attached medical profile to a physician-operated computer at a network location separate from said patient-operated computer and said workflow engine (Hawkins; col. 3, lines 40-42; the examiner interprets the "web server" as the physician-operated computer");

using a second medical messaging wizard from said physician-operated computer, generating a response message and directing said response to said patient (Hawkins; col. 3, lines 42-47).

Hawkins fails to expressly teach the messaging system involves patients and physicians comprising a computer operated by a physician and a computer operated by a patient and viewing said query message by a first physician. However, these features are old and well known in the art, as evidenced by Sato's teachings with regards to a messaging system involving patients and physicians comprising a computer operated by a physician and a computer operated by a patient and viewing said query message by a first physician (Sato; abstract and col. 2, lines 7-31) It is respectfully submitted, that it would have been obvious, to one having ordinary skill in the art at the time the invention was made, to modify the system taught by Hawkins with Sato's teaching with regards to a messaging system involving patients and physicians comprising a computer operated by a physician and a computer operated by a patient and viewing said query message by a first physician, with the motivation of providing a patient located in a remote area a remote examination and treatment services of high satisfaction and medical treatment related services other than examination and

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treatment regardless of the location of the doctor/facilities relative to the patient (Sato; col. 1, line 66-col. 2, line 6).

The combined system of Hawkins and Sato collectively fail to expressly teach wherein the electronic form is a problem-specific, patient-specific electronic form generated from a problem-related database and a patient's medical profile. However, these features are old and well known in the art, as evidenced by Sloane's teachings with regards generating a problem-specific, patient-specific electronic form from a problem-related database and said patient's medical profile (Sloane; abstract and col. 3, line 48-col. 4, line 58, col. 5, lines 52-59, and col. 7, lines 35-65) It is respectfully submitted, that it would have been obvious, to one having ordinary skill in the art at the time the invention was made, to expand the collective system taught by Hawkins and Sato with Sloane's teaching with regards to this limitation, with the motivation of bringing the body of medical knowledge and skill, as well as relevant epidemiological consideration, that bear on the diagnosis and treatment of diseases and illnesses, in a more efficient and effective way (Sloane; col. 1, lines 40-46).

As per the term "message wizard" in claim 87, note Hawkins' teachings with respect to the use of easy-to-fill forms in order to submit messages or queries (Hawkins; col. 12, lines 40-67).

(B) As per claim 88, the combined system of Hawkins and Sloane collectively fail to expressly teach appending billing to said response and generating a patient response log entry in a medical profile. However, this feature is old and well known in the art, as

evidenced by Sato's teachings with regards to appending a billing to said response (Sato; col. 6, lines 11-17) and generating a patient response log entry in a medical profile (Sato; abstract; the examiner interprets the "electronic case record file" as a form of a "medical profile.") It is respectfully submitted, that it would have been obvious, to one having ordinary skill in the art at the time the invention was made, to expand the collective system taught by Hawkins and Sloane with Sato's teaching with regards to appending a billing to said response, with the motivation of providing a patient located in a remote area a remote examination and treatment services of high satisfaction and medical treatment related services other than examination and treatment regardless of the location of the doctor/facilities relative to the patient (Sato; col. 1, line 66-col. 2, line 6).

(C) As per claim 92, the collective system of Hawkins and Sloane fail to expressly teach this limitation. However, this feature is old and well known in the art, as evidenced by Sato's teachings with regards to embedding a prescription in a response message from a physician to a patient in a networked system (Sato; col. 5, lines 59-67 and fig. 1). It is respectfully submitted, that it would have been obvious, to one having ordinary skill in the art at the time the invention was made, to modify the collective system taught by Hawkins and Sloane with Sato's teachings with regards to embedding a prescription in a response message from a physician to a patient in a networked system, with the motivation of providing a patient located in a remote area a remote examination and treatment services of high satisfaction and medical treatment related

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services other than examination and treatment regardless of the location of the doctor/facilities relative to the patient (Sato; col. 1, line 66-col. 2, line 6).

(D) As per claim 97, the combined system of Hawkins and Sloane collectively fail to expressly teach generating a billing report from said medical profile of said patient. However, this feature is old and well known in the art, as evidenced by Sato's teachings with regards to generating a billing report from said medical profile of said patient (Sato; col. 7, lines 39-56; the examiner interprets the "accounting file" as a form of "billing report"). It is respectfully submitted, that it would have been obvious, to one having ordinary skill in the art at the time the invention was made, to expand the collective system taught by Hawkins and Sloane with Sato's teaching with regards to generating a billing report from said medical profile of said patient, with the motivation of providing a patient located in a remote area a remote examination and treatment services of high satisfaction and medical treatment related services other than examination and treatment regardless of the location of the doctor/facilities relative to the patient (Sato; col. 1, line 66-col. 2, line 6).

(E) As per claim 98, the combined system of Hawkins and Sloane collectively fail to expressly teach the limitations of this claim. However, these feature are old and well known in the art, as evidenced by Sato's teachings with regards to said network including a billing system accessing said network at a billing system address on said network (Sato; col. 2, lines 58-62 and fig. 1; the examiner interprets the "financial

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institution" as the "billing system accessing said network") and sending said billing report from said medical profile of said patient to said billing system address (Sato; col. 2, lines 60-61; the examiner interprets "asks the financial institution to pay for the treatment for the patient" as "sending said billing report from said medical profile of said patient to said billing system address") and billing said patient from said billing report (Sato; col. 2, lines 61-63; the examiner interprets "automatically withdraws the treatment fee from the patient's account" as a form of "billing said patient from said billing report.") It is respectfully submitted, that it would have been obvious, to one having ordinary skill in the art at the time the invention was made, to expand the collective system taught by Hawkins and Sloane with Sato's teaching with regards to these limitations, with the motivation of eliminating the problem of waiting for accounting which is required in a conventional hospital (Sato; col. 3, lines 27-30).

(F) As per claim 99, the combined system of Hawkins and Sloane collectively fail to expressly teach wherein billing said patient comprises either of generating a personal bill for said patient and generating at least one insurance bill for said patient to a corresponding insurance provider. However, this feature is old and well known in the art, as evidenced by Sato's teachings with regards to wherein billing said patient comprises either of generating a personal bill for said patient and generating at least one insurance bill for said patient to a corresponding insurance provider (Sato; col. 2, lines 61-63; the examiner interprets "the financial institution automatically withdraws the treatment fee from the patient's account" as a form of "generating a personal bill for

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said patient.”). It is respectfully submitted, that it would have been obvious, to one having ordinary skill in the art at the time the invention was made, to expand the collective system taught by Hawkins and Sloane with Sato’s teaching with regards to these limitations with the motivation of eliminating the problem of waiting for accounting which is required in a conventional hospital (Sato; col. 3, lines 27-30).

(G) As per claims 103-105, Hawkins teaches wherein said messaging protocol supports email, TCPIP, and the World Wide Web (Hawkins; col. 10, lines 13-16 and col. 11, lines 20-27).

(H) As per claims 106 and 107, Hawkins’s system is implemented on a computer (Hawkins; col. 8, lines 5-17). As such, Hawkins implicitly includes computer elements such as a programmed computer readable medium.

(I) As per claim 108, Hawkins teaches wherein said workflow engine resides on at least one server capable of accessing said network to receive and send messages and wherein said workflow engine process is implemented as a program system wherein the various stated operations of said process are implemented as a program system wherein the various stated operations are implemented as component programs which may be concurrently operating (Hawkins; fig. 1 and col. 3, lines 33-47; the examiner interprets the process of the “server” as the “workflow engine process.”)

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(J) As per claim 109, Hawkins teaches wherein said workflow engine resides on exactly one server capable of accessing said network to receive and send message (Hawkins; fig. 1; the examiner interprets the "proxy server" as the "workflow engine.")

(K) Claim 110 repeats features of claims 87 and 88 and therefore is rejected for the same reasons given above in the rejection of claims 87 and 88 and incorporated herein

(L) As per claim 111, the combined system of Hawkins and Sloane collectively fail to expressly teach code for determining said first physician based upon said query message received from said patient. However, this feature is old and well known in the art, as evidenced by Sato's teachings with regards to code for determining said first physician based upon said query message received from said patient (Sato; col. 2, lines 16-31). It is respectfully submitted, that it would have been obvious, to one having ordinary skill in the art at the time the invention was made, to expand the collective system taught by Hawkins and Sloane with Sato's teaching with regards to these limitations with the motivation of providing a patient located in a remote area a remote examination and treatment services of high satisfaction and medical treatment related services other than examination and treatment regardless of the location of the doctor/facilities relative to the patient (Sato; col. 1, line 66-col. 2, line 6).

6. Claim 89 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hawkins et al. (6,343,318), Sato et al. (5,911,687), and Sloane (5,619,991) as applied to claim 88 above and further in view of Colvin (5,825,881).

(A) As per claim 89, Hawkins teaches:

encrypting said query message at said patient-operated computer (Hawkins; col. 237, lines 1-6);

However, Hawkins, Sato, and Sloane collectively fail to expressly teach the remaining limitations. However, these features are old and well known in the art, as evidenced by Colvin's teachings with regards to the steps of;

decrypting said encrypted query message at said workflow engine (Colvin; col. 14, lines 4-17; the examiner interprets the "central server" as the "workflow engine");

encrypting said decrypted query message at said workflow engine (Colvin; col. 14, lines 13-15);

decrypting said query message from said workflow engine at said physician-operated computer (Note Colvin teaches the client decrypting a message with its respective encryption key Colvin; col. 6, lines 15-40) ; and

any of the steps of:

decrypting said encrypted response message at said workflow engine;

and

decrypting said encrypted response message at said patient-operated computer (Colvin; col. 14, lines 1-17; It is respectfully submitted, that the central

server can decrypt messages from the second client computer system similar to the way it does with messages from the first client computer system).

It is respectfully submitted, that it would have been obvious, to one having ordinary skill in the art at the time the invention was made, to modify the collective system taught by Hawkins, Sato, and Sloane with Colvin's teaching with regards to these limitations, with the motivation of reducing the risk that confidential information will be intercepted or misused (Colvin; col. 2, lines 20-22).

7. Claims 90, 91, 96, 100, and 113-116 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hawkins et al. (6,343,318), Sato et al. (5,911,687), and Sloane (5,619,991), as applied to claims 87 and 110 above and further in view of Falchuk et al. (6,256,613).

(A) As per claim 90, Hawkins, Sato, and Sloane collectively fail to expressly teach the limitations of this claim. However, these features are old and well known in the art, as evidenced by Falchuk's teachings with regards to:

routing said query message with said attached medical profile to a physician extender using a computer at a separate network location (Falchuk; abstract; the examiner interprets the "staff physician" as a form of "physician extender");

selecting a first of said physician extenders (Falchuk; abstract; the examiner interprets the "client computer" as the "medical profiler");

using a third medical message wizard (Falchuk; abstract; the examiner interprets the means to "display request for preliminary review" as the "third medical message wizard");

viewing said query message by said physician extender (Falchuk; abstract);

generating a proposed response message to said query message (Falchuk; abstract; the examiner interprets the "request" sent to the "specialist" as the "proposed patient response message") ;

attaching said proposed response message to said query message(Falchuk; abstract)

routing said query message with said proposed response message to said first physician (Falchuk; abstract; the examiner interprets the "specialist" as the "first-physician"); and

generating said response message by said first physician using said medical message wizard based on said proposed response message (Falchuk; abstract).

It is respectfully submitted, that it would have been obvious, to one having ordinary skill in the art at the time the invention was made, to modify the collective system taught by Hawkins, Sato, and Sloane, with Falchuk's teaching with regards to these limitations, with the motivation of providing managed, direct access to outside medical consultants, therefore help avoid inaccurate, incomplete, or uncertain diagnoses which can result in inappropriate or excessive care (Falchuk; col. 1, lines 40-43).

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(B) As per claim 91, the combined system of Hawkins, Sato, Sloane, and Falchuk collectively fail to expressly teach said physician extender comprises either of an administrator or a physician assistant. However, it is respectfully submitted, that such a limitation is directed to who or what utilizes the claimed invention rather than a limitation drawn to what the claimed invention is, as such it would have been obvious, to one having ordinary skill in the art at the time the invention was made, to modify the collective system taught by Hawkins, Sato, Sloane, and Falchuk to have said physician extenders as an administrator or a physician assistant, with the motivation of freeing up physicians, by enabling their support personal to perform the functions required by the system.

(C) As per claim 96, the collective system of Hawkins Sloane, and Falchuk collectively fail to expressly teach this limitation. However, this feature is old and well known in the art, as evidenced by Sato's teachings with regards to embedding a prescription in a response message from a physician to a patient in a networked system (Sato; col. 5, lines 59-67 and fig. 1). It is respectfully submitted, that it would have been obvious, to one having ordinary skill in the art at the time the invention was made, to modify the collective system taught by Hawkins, Sloane, and Falchuk with Sato's teachings with regards to embedding a prescription in a response message from a physician to a patient in a networked system, with the motivation of providing a patient located in a remote area a remote examination and treatment services of high satisfaction and medical treatment related services other than examination and

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treatment regardless of the location of the doctor/facilities relative to the patient (Sato; col. 1, line 66-col. 2, line 6).

(D) As per claim 100, the collective system of Hawkins Sato, and Sloane collectively fail to expressly teach these limitations. However, this feature is old and well known in the art, as evidenced by Falchuk's teachings with regards to:

generating a first-physician-second opinion request message (Falchuk; abstract; the examiner interprets the "staff physician" as the "first physician" and interprets the "request for consultation, together with at least an identification of the selected supporting documentation" as the "first-physician-second-opinion request message");

sending said first-physician-second opinion request message to a second physician at a corresponding physician address (Falchuk; abstract);

viewing said second opinion request message by said second physician (Falchuk col. 4, lines 48-52);

generating a second opinion message by said second physician; and sending said second opinion message to said first physician (Falchuk; abstract).

It is respectfully submitted, that it would have been obvious, to one having ordinary skill in the art at the time the invention was made, to modify the collective system taught by Hawkins, Sato, and Sloane with Falchuk's teachings with regards to these limitations, with the motivation providing managed, direct access to outside medical consultants, therefore help avoid inaccurate, incomplete, or uncertain

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diagnoses which can result in inappropriate or excessive care (Falchuk; col. 1, lines 40-43).

(E) As per claim 113, the collective system of Hawkins Sato, and Sloane collectively fail to expressly teach these limitations. However, this feature is old and well known in the art, as evidenced by Falchuk's teachings with regards to code for generating a second query message based upon said received query message from said patient and sending said second query message based upon said received query message from said patient and sending said second query message to a first of said physician extender computer (Falchuk; abstract; the examiner interprets the "structured request" as the "second patient medical query message). It is respectfully submitted, that it would have been obvious, to one having ordinary skill in the art at the time the invention was made, to modify the collective system taught by Hawkins, Sato, and Sloane with Falchuk's teachings with regards to these limitations, with the motivation providing managed, direct access to outside medical consultants, therefore help avoid inaccurate, incomplete, or uncertain diagnoses which can result in inappropriate or excessive care (Falchuk; col. 1, lines 40-43).

(F) Claim 114 repeats the features of claims 90 and 111 and is therefore rejected for the same reasons given above in the rejections of claims 90 and 111 and incorporated herein.

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(G) Claim 115 repeats the features of claims 88 and 90 and is therefore rejected for the same reasons given above in the rejections of claims 88 and 90 and incorporated herein.

(H) Claim 116 repeats the features of claim 90 and is therefore rejected for the same reasons given above in the rejections of claim 90 and incorporated herein.

8. Claim 93 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hawkins et al. (6,343,318), Sato et al. (5,911,687), and Sloane (5,619,991) as applied to claim 92 above and further in view of Merck-Medco ("Merck-Medco Announces Interactive Web Site," News Release, October 27, 1998).

(A) As per claim 93, the combined system of Hawkins, Sato, and Sloane fail to expressly teach selecting a pharmacy by said patient and directing a message to said pharmacy by said patient ordering said prescription. However, this feature is old and well known in the art, as evidenced by Merck-Medco's teachings with regards to selecting a pharmacy by said patient and directing a message to said pharmacy by said patient ordering said prescription (Merck-Medco; page 1, paragraphs 1 and 2). It is respectfully submitted, that it would have been obvious, to one having ordinary skill in the art at the time the invention was made, to modify the collective system taught by Hawkins, Sato, and Sloane with Merck-Medco's teachings with regards the above

limitations, with the motivation of reducing paperwork and improving the administration of pharmacy benefits (Merck-Medco; page 1; paragraph 6).

9. Claims 94 and 95 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hawkins et al. (6,343,318), Sato et al. (5,911,687), Sloane (5,619,991), and Falchuk et al. (6,256,613) as applied to claim 90 above and further in view of Business Wire ("Merck-Medco and Physicians' Online Pilot New suite of Internet Applications To Facilitate Physician and Pharmacist Communications At the Point of Prescribing," Business Wire, October 22, 1998).

(A) As per claim 94, the combined system of Hawkins, Sato, Sloane, and Falchuk fail to expressly teach embedding a proposed prescription refill in said proposed response. However, this feature is old and well known in the art, as evidenced by Business Wire's teachings with regards to embedding a proposed prescription refill in said proposed response (Business Wire; page 2, paragraph 2). It is respectfully submitted, that it would have been obvious, to one having ordinary skill in the art at the time the invention was made, to modify the collective system taught by Hawkins, Sato, Sloane, and Falchuk with Merck-Medco's teachings with regards the above limitations, with the motivation of facilitating communications at the point of prescribing between pharmacists and physicians (Business Wire; page 1; paragraph 1).

The combined system of Hawkins, Sato, Sloane, Falchuk, and Business Wire fail to expressly teach said physician extender comprises a nurse. However, it is respectfully submitted, that such a limitation is directed to who or what utilizes the

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claimed invention rather than a limitation drawn to what the claimed invention is, as such it would have been obvious, to one having ordinary skill in the art at the time the invention was made, to modify the collective system taught by Hawkins, Sato, Sloane, Falchuk, and Business Wire to have said physician extenders as a nurse, with the motivation of freeing up physicians, by enabling their support personal to perform the functions required by the system.

(B) As per claim 95, the combined system of Hawkins, Sato, Sloane, and Falchuk fail to expressly teach the limitations of this claim. However, this feature is old and well known in the art, as evidenced by Business Wire's teachings with regards to reviewing said proposed prescription refill by said first physician and any of the steps of:

- approving said proposed prescription refill;

- revising said proposed prescription refill;

- deleting said proposed prescription refill; and

- embedding a second prescription (Business Wire; page 1, paragraph 4). It is respectfully submitted, that it would have been obvious, to one having ordinary skill in the art at the time the invention was made, to modify the collective system taught by Hawkins, Sato, Sloane, and Falchuk with Business Wire's teachings with regards the above limitations, with the motivation of facilitating communications at the point of prescribing between pharmacists and physicians (Business Wire; page 1; paragraph 1).

10. Claim 101 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hawkins et al. (6,343,318), Sato et al. (5,911,687), and Sloane (5,619,991) as applied to claim 87 above and further in view of Donohue et al. (5,987,480).

(A) As per claim 101 the combined system of Hawkins, Sato, and Sloane fail to expressly teach maintaining a collection of patient response templates, wherein said first physician invokes one of said collection of templates in responding to said query message. However, this feature is old and well known in the art, as evidenced by Donohue's teachings with regards to maintaining a collection of patient response templates, wherein said first physician invokes one of said collection of templates in responding to said query message (Donohue; abstract; it is respectfully submitted that "said first physician" is a form of "client"). It is respectfully submitted, that it would have been obvious, to one having ordinary skill in the art at the time the invention was made, to modify the collective system taught by Hawkins, Sato, and Sloane with Donohue's teachings with regards the above limitations, with the motivation of providing web pages to users which are customized and individualized to each users particular needs and interest (Donohue; col. 3, lines 9-11).

11. Claim 102 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hawkins et al. (6,343,318), Sato et al. (5,911,687), and Sloane(5,619,991) as applied to claim 87 above and further in view of Pinsky et al. (5,469,353).

(A) As per claim 102 the combined system of Hawkins, Sato, and Sloane fail to expressly teach these limitations. However, this feature is old and well known in the art, as evidenced by Pinsky's teachings with regards to:

maintaining a routing table including at least one routing directive to said first physician (Pinsky; col. 4, lines 5-26; the examiner interprets "resource of available Network interpretation sites" as a "routing table including at least one routing directive to said first physician");

wherein sending said patient medical query message to a first physician with said corresponding physician address further comprises:

examining said routing table based upon said patient medical query message to find a first of said routing directives to said first physician compatible with said patient medical query message (Pinsky; col. 4, lines 16-26; the examiner interprets the "Study" as a form of "medical query message"); and

finding said first routing directive to said first physician compatible with said patient medical query message (Pinsky; col. 4, lines 16-26).

It is respectfully submitted, that it would have been obvious, to one having ordinary skill in the art at the time the invention was made, to modify the collective system taught by Hawkins, Sato, and Sloane with Pinsky's teachings with regards to the above limitations, with the motivation of matching the patient request with the physician best equipped and able to handle the specific needs of the request (Pinsky; col. 3, lines 41-53).

12. Claim 112 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hawkins et al. (6,343,318), Sato et al. (5,911,687), and Sloane (5,619,991), Merck-Medco ("Merck-Medco Announces Interactive Web Site," News Release, October 27, 1998), Falchuk et al. (6,256,613), and Business Wire ("Merck-Medco and Physicians' Online Pilot New suite of Internet Applications To Facilitate Physician and Pharmacist Communications At the Point of Prescribing," Business Wire, October 22, 1998) as applied to claim 110 above.

(A) Claim 112 repeats the features of claims 93 and 94 and is therefore rejected for the same reasons given above in the rejections of claims 93 and 94 and incorporated herein.

13. Claims 117 and 118 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hawkins et al. (6,343,318), Sato et al. (5,911,687), and Sloane (5,619,991) as applied to claim 110 above and further in view of Masuo et al. (6,154,444).

(A) As per claim 117, Hawkins, Sato, and Sloane fail to expressly disclose the limitations of this claim. However, these features are old and well known in the art, as evidenced by Massuo's teachings with regards to:

code for generating a routing tree comprised of at least one routing arrow based upon said received query, each of said routing arrows contains a source and a destination belonging to a tree routing collection comprised of at least each of said physicians, and each of said routing arrows connecting to form a chain containing a final

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destination of said first physician (Masuo; col. 2, lines 8-44; the examiner interprets the "connection setup message" as the "received educated query", the "route table" as a form of "routing tree," and it is respectfully submitted, that the final "node" could be "said first-physician" if desired); and

code for generating a source patient query message for each said source of each said routing arrow of said routing tree containing said chain of said routing arrow and sending said source patient query message to said source of said routing arrow of said routing tree (Masuo; col. 2, lines 8-44).

It is respectfully submitted, that it would have been obvious, to one having ordinary skill in the art at the time the invention was made, to modify the collective system taught by Hawkins, Sato, and Sloane with Masuo's teaching with regards to the above limitations, with the motivation of providing a source routing method for quickly establishing a connection in a connection-oriented network when the connection encounters an unfavorable network connection (Masuo; col. 1, lines 38-41).

(B) Claim 118 repeats the features of claims 88 and 90 and is therefore rejected for the same reasons given above in the rejections of claims 88 and 90 and incorporated herein.

Response to Arguments

14. Applicant's arguments with respect to cancelled claim 1 have been considered but are moot in view of the new ground(s) of rejection.

(A) At page 12 of the 3/12/03 communication, Applicant argues the combination of References, in reference to claim 1. However, the arguments concern cancelled claim 1 and are therefore moot.

However, Examiner has maintained the same combination of references and thus will respond accordingly. The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

In addition, in the instant case, the Examiner respectfully notes that each and every motivation to combine the applied references are accompanied by select portions of the respective reference(s), which specifically support that particular motivation. As such, it is NOT seen that the Examiner's combination of references is unsupported by the applied prior art of record. Rather, it is respectfully submitted that explanation based on the logic and scientific reasoning of one ordinarily skilled in the art at the time of the invention that support a holding of obviousness has been adequately provided by the motivations and reasons indicated by the Examiner, *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter., 4/22/93).

Furthermore, the Examiner respectfully notes that the cited reference was never applied as a reference under 35 U.S.C. 102 against the pending claims. As such, the Examiner respectfully submits that the issue at hand is not whether the applied prior art specifically teaches the claimed features, *per se*, but rather, whether or not the prior art, when taken in combination with the knowledge of average skill in the art, would put the artisan in possession of these features. Regarding this issue, it is well established that references are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures, *In re Bozek*, 163 USPQ 545 (CCPA 1969). The issue of obviousness is not determined by what the references expressly state but by what they would reasonably suggest to one of ordinary skill in the art, as supported by decisions in *In re DeLisle* 406 Fed 1326, 160 USPQ 806; *In re Kell, Terry and Davies* 208 USPQ 871; and *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ 2d 1596, 1598 (Fed. Cir. 1988) (citing *In re Lalu*, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1988)). Further, it was determined in *In re Lamberti et al*, 192 USPQ 278 (CCPA) that:

- (i) obviousness does not require absolute predictability;
- (ii)____non-preferred embodiments of prior art must also be considered; and
- (iii) the question is not express teaching of references, but what they would suggest.

According to *In re Jacoby*, 135 USPQ 317 (CCPA 1962), the skilled artisan is presumed to know something more about the art than only what is disclosed in the applied references. In *In re Bode*, 193 USPQ 12 (CCPA 1977), every reference relies

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to some extent on knowledge of persons skilled in the art to complement that which is disclosed therein.

According to *Ex parte Berins*, 168 USPQ 374 (Bd. Appeals), there is no statutory limitation as to the number of references that may be used to demonstrate obviousness...not what references expressly state but what they would reasonably suggest to one of ordinary skill in the art. In *In re Conrad*, 169 USPQ 170 (CCPA), obviousness is not based on express suggestion, but what references taken collectively would suggest.

Conclusion

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Milan S Kapadia whose telephone number is 703-305-3887. The examiner can normally be reached on Monday through Thursday, 8:30 A.M. to 6:00 P.M. In addition the examiner can be reached on alternate Fridays.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 703-305-9588. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

mk

March 26, 2003


DINH X. NGUYEN
PRIMARY EXAMINER